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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,751	11/16/2001	David G. Chame	1311	8260

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EXAMINER

KRUSE, DAVID H

ART UNIT PAPER NUMBER

1638

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,751

Applicant(s)

CHARNE ET AL.

Examiner

David H Kruse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 35-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 9-15 is/are allowed.
- 6) ☒ Claim(s) 8, 35, 37, 39 and 41 is/are rejected.
- 7) ☒ Claim(s) 36, 38 and 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is in response to the Amendment and Remarks filed 26 October 2004.
2. Those rejections not specifically addressed in this Office action are withdrawn in view of Applicant's amendments.
3. The rejection of claim 3 under 35 USC § 112, first paragraph is withdrawn in view of Applicant's arguments on pages 7-8 of the Remarks.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Allowable Subject Matter

5. Claims 1-7, and 9-15 are allowed.
6. Claims 36, 38 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

7. Claims 8, 35, 37 and 39 remain rejected and claim 41 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is repeated for the reason of record as set forth in the last Office action mailed 1

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September 2004. Applicant's arguments filed 26 October 2004 have been fully considered but they are not persuasive.

New claim 41 lacks adequate written description because at step (c), the claimed method comprises "crossing...one or more times". The instant claim is directed to using progeny plants of the described NS3213 plant beyond the F1 generation. The Examiner has withdrawn the instant rejection as directed to F1 progeny *Brassica napus* plants and parts thereof produced by crossing NS3213 with another *Brassica napus* plants. Use of subsequent progeny lacks adequate written description for the reasons of record. A method is not described if products used in the method are not described. See 64 Fed. Reg. 71427, 71428 (1999), comment No. 4.

As directed to claim 8, Applicant argues that the first "product used" (the first *Brassica* plant) having the claimed traits has been fully described in the specification by a description of breeding methods, by disclosure of the breeding history of NS3213 and by a deposit of NS3213 seeds (page 7, 3rd paragraph of the Remarks). This argument is not found to be persuasive because it is unclear if the instant method is directed to the use of progeny beyond the F1 generation. The Examiner suggests that replacing "further comprising" with -- wherein said breeding is performed by -- to clearly indicate that the F1 progeny produced in claim 7 is further used in a breeding program. Such an amendment would obviate this rejection as directed to claim 8.

Applicant states that the rejection as directed to claims 35, 37 and 39 is unclear and that Claims 35-40 definitely provide an incremental value over prior *Brassica napus* plants which do not exhibit the combination of having an "R" rating for blackleg and

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resistance to at least one AHAS-inhibitor herbicide (page 8, 5th paragraph of the Remarks). The Examiner's remarks are directed to the fact that Applicant does not describe what genes control resistance to blackleg or the structure of the gene controlling AHAS-inhibitor herbicide resistance, Applicant has failed to adequately describe progeny of NS3213 as broadly claimed, even with an "R" rating for blackleg and resistance to at least one AHAS-inhibitor herbicide as broadly claimed. The art recognizes that in the cross between two, non-self, breeding partners, that the genotypes produced are unique and new. Hence, without an adequate written description of the genetic makeup of NS53213, one cannot describe progeny beyond the F1 generation.

Applicant argues that in order for progeny to meet the claims, there must be sufficient structure (genetics) from variety N53213 to supply the traits, and that one of skill in the art can readily recognize that Applicant was in possession of the invention as claimed (paragraph spanning pages 8-9 of the Remarks). This argument is not found to be persuasive for the reasons of record and reasons given supra.

8. Claims 8 35, 37 and 39 remain rejected and claim 41 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is repeated for the reason of record as set forth in the last Office action mailed 1 September 2004. Applicant's

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arguments filed 26 October 2004 have been fully considered but they are not persuasive.

Applicant's arguments, as directed to claim 8, state that said claim has been amended to require that the second *Brassica* plant is a *Brassica napus* plant (page 9 of the Remarks). This argument is not found to be persuasive for the reasons given supra for the issue of written description. If claim 8 is amended to clearly indicate that the F1 progeny plant is further used in one of the listed breeding methods, then this rejection would be considered moot, and limiting said claim to *Brassica napus* would not be necessary and/or unduly limiting of Applicant's invention. The Examiner considers any F1 progeny of NS3213 having an "R" rating for blackleg and resistance to at least one AHAS-inhibitor herbicide, and methods of use, adequately enabled.

The argument and response as directed to commercial viability appears to be unclear to both the Applicant and to the Examiner (page 9 of the Remarks). The Examiner was pointing out that while commercial viability of a product or a method of use is not a standard for patentability, that one of skill in the art would consider commercial traits in the use of the claimed method. This argument does not seem to be productive.

As directed to claims 35, 37, 39 and 40, Applicant argues that said claims are limited to progeny of *Brassica napus*, that resistant plants are selected on a phenotypic basis and that methods of selecting plants resistant to blackleg and an AHAS-inhibitor are taught in the specification. Applicant argues that one skilled in the art does not need to know specifically which alleles are present at which resistance genes in

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individual lines, one must only select for resistant plants and that these are selectable and do not constitute undue trial and error experimentation (pages 10-11 of the Remarks). These arguments are not found to be persuasive because Applicant has not taught the nature of the blackleg resistance or herbicide resistance. Without such a teaching, one of skill in the art at the time of Applicant's invention could not adequately distinguish the claimed *Brassica napus* progeny plant from others made using other *Brassica napus* plants, hence would not be able to determine if there was any issue of infringement. With each generation, the genetic signature of NS3213 would be further diluted with that of other breeding partners and the ability of one of skill in the art to distinguish a progeny of NS3213 from other *Brassica napus* plants having an "R" rating for blackleg and resistance to at least one AHAS-inhibitor herbicide would require undue trial and error experimentation. New claim 41 is included in the instant rejection because it is directed to a method of using progeny plants beyond the F1 generation.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

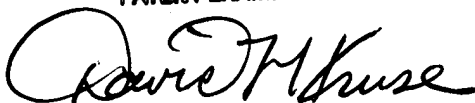
10. Claims 8, 35, 37, 39 remain rejected and new claim 41 is rejected.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Amy Nelson can be reached at (571) 272-0804. The fax telephone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-0547.

DAVID H. KRUSE, PH.D.
PATENT EXAMINER

A handwritten signature in black ink, appearing to read "David H. Kruse", written in a cursive style.

David H. Kruse, Ph.D.
6 January 2005

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12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

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